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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : BARBARA PAPADOPOULOU ET AL.
Appl'n. No. : 08/931,721
Filed : September 16, 1997
Title : MACROPHAGE-INFECTING PARASITES EXPRESSING A
GRANULOCYTE MACROPHAGE COLONY STIMULATING
FACTOR
Docket No. : 1038-729 MIS:sd

January 22, 2003

BY COURIER

The Commissioner of Patents
and Trademarks,
Box DAC
Washington, D.C. 20231,
U.S.A.

RECEIVED

JAN 27 2003

OFFICE OF PETITIONS

FURTHER RENEWED PETITION TO REVIVE AN ABANDONED APPLICATION

Sir:

This Further Renewed Petition to Revive this abandoned application is submitted following the Decision on Petition dated November 23, 2002.

The Decision is correct in stating that the cause of abandonment was a failure to reply in timely manner to the Notification of Non-compliance with 37 CFR 1.192(c) mailed July 19, 2000 ("Notice"). The Decision is correct that a Petition to Revive this application under 37 CFR 1.137(b) was filed September 29, 2000, along with an Amended Appeal Brief intended to remedy the defects outlined in the Notice.

The Decision on the Petition mailed September 17, 2002 advised that the Amended Appeal Brief failed to place the application in condition for allowance. However, it is unnecessary that an Amended Appeal Brief submitted in response to a Notification of Non-compliance under 37 CFR 1.192(c) actually place the application in condition for allowance. The step of prosecution after the filing of an Appeal Brief is for the Examiner to consider the Brief and, if not satisfied with respect

to patentability, issue an Examiner's Answer. The applicants had considered they had corrected the defects by the Amended Appeal Brief.

For the first time in this Petition proceedings, it is suggested in the Decision on Petition dated December 23, 2002 that the Amended Appeal Brief was still considered defective in the statement:

“...Petitioner has yet to make the required correction(s) and has thus failed to file a complete and proper reply as the condition of the case required.”

The undersigned contacted the prosecution Examiner by telephone with respect thereto and the Examiner advised that, when consulted by the Petitions attorney with respect to the Amended Appeal Brief and the original Petition, that the Examiner considered the Amended Appeal Brief still to be defective and outlined the defects to the Petitions attorney.

These facts were not communicated to Petitioner in the Decision on Petition dated September 17, 2002, nor in that of December 23, 2002. According to the prosecution Examiner, the “required reply” was considered not to have been made since applicants were considered not to have fully dealt with the defects in this notice and not that the Amended Appeal Brief failed to place the application in condition for allowance, as stated in the Decision dated September 17, 2002.

It is appreciated that the Office letter mailed July 19, 2000 and the Notice of Non-compliance are not mutually exclusive documents, nor has Petitioner treated them as if they were. However with regard to the statement:

“...Petitioner's focus on whether the notice of Abandonment correctly or incorrectly advises the reason for abandonment is misplaced.”

it is submitted this applicant should be entitled to know why their applications are abandoned, so that the correct steps can be taken to revive the same, in the event the abandonment was inadvertent or unintentional.

The fact remains that the Notice of Abandonment did incorrectly identify the basis on which the application was considered to be abandoned. It was stated that applicants' reply to the Office letter of July 19, 2000, namely the amended Appeal Brief discussed above, did not constitute a proper reply to the final rejection. A

proper reply to the final rejection had previously been filed, namely a Notice of Appeal and Appeal Brief.

The Petitions attorney correctly quotes from 37 CFR 1.135(a) the conditions under which an application can become abandoned. It is appreciated that applications automatically become abandoned under the conditions of 37 CFR 1.135(a) and that it is unnecessary for the Office to send out a Notice of Abandonment.

In the present case, as explained in the original Petition, applicants' attorney realized that there was an outstanding requirement not attended to in timely manner, namely the Notice of Non-compliance. Applicants' attorney prepared a Response to Notification of Non-compliance and an Amended Appeal Brief, in the belief that the Amended Appeal Brief dealt with all the defects noted in the Notice of Non-compliance and submitted the original Petition dated September 28, 2000, in the honest belief that the Amended Appeal Brief satisfied the proper reply provision of 37 CFR 1.137(b).

At no time did Petitioner assert that the Notice of Appeal and Appeal Brief constituted a proper reply to the Notice, as suggested in the Decision on Petition dated December 23, 2002. Petitioner consistent argument has been that the Amended Appeal Brief was a proper reply to the Notice. In the Renewed Petition, Petitioner was commenting on the reason for abandonment given in the Notice of Abandonment. The Amended Appeal Brief was stated abandonment not to be a response to a final rejection but to the Notice. The Petitioner noted that the Applicants' had previously filed a reply to the final rejection, namely a Notice of Appeal and Appeal Brief. It is believed that the Petitions attorney has read the last sentence of the second complete paragraph on page 2 of the Renewed Petition to Revive out of the context of the paragraph and the totality of Petitioner's submission.

Having regard to the second complete paragraph on page 3 of the Decision on Petition, the chronology of events outlined is incorrect. While the Notice of Abandonment was mailed September 10, 2002, the Decision on Petition was not mailed until September 17, 2002, as a corrected Decision on Petition, no other Decision having been received. However, applicants have never been advised of the correct reason why the case is still considered to be abandoned, only discerned

through a recent telephone conversation with the prosecution Examiner, namely that Amended Appeal Brief submitted with the original Petition was considered still not to comply with the provisions of 37 CFR 1.192(c).

In the Decision on Petition dated September 17, 2002, it is stated that the Petition did not satisfy the required reply provision of 37 CFR 1.137(b) because "the amended brief fails to place the application in condition for allowance" while the Notice of Abandonment indicated that applicants amended brief did not constitute "a proper reply to a final rejection". The filing of an Appeal Brief requires an action by the Examiner while applicants had already responded to the final rejection.

The Petitions attorney states:

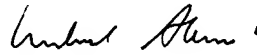
"...Petitioners failure is a result of the insufficiency of the reply, specifically the failure to file a complete and proper reply, as the condition of the case requires".

This statement is the second time that it is suggested that all may not be considered well with the Amended Appeal Brief. If it had been clearly stated in the Decision on Petition dated September 17, 2002 or in the Notice of Abandonment dated September 10, 2002 that the Amended Appeal Brief submitted with the Petition was considered still not to comply with 37 CFR 1.192(c) and the reasons therefor, the applicants would have been better able to deal with the matter. As discussed above, Petitioner has always considered the Amended Appeal Brief to have been a proper reply to the Notice and it was not disabused of this understanding until a telephone conversation with the prosecution Examiner following receipt of the Decision on Petition dated December 23, 2002.

At this juncture, rather than pursue the question of the manner in which the Amended Appeal Brief may still be considered defective and attempt to effect further corrections, it would appear more expeditious to proceed on the basis of continued examination and, as a proper reply to the Notification of Non-compliance with 37 CFR 1.192(c), submitted herewith is a Request for Continued Examination (RCE).

Having regard to the submission of the RCE, it is submitted that Applicants' Petition does not lack item (a) required by 37 CFR 1.137(b) and that the Petition should be allowed and the application returned to pending status.

Respectfully submitted,



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